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EXAMINER	
MACARTHUR, VICTOR L	
ART UNIT	PAPER NUMBER

3679  
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/865,125	LARSEN ET AL.	
	Examiner	Art Unit	
	Victor MacArthur	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 16 June 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-30 and 38-43 is/are pending in the application.

4a) Of the above claim(s) 2,10-13,16,17,19,20 and 38-42 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 3, 4-9, 14, 15, 18, 21-23, 24-30, 43 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

The examiner notes the applicant's assertion that figures 2A, 2B and 2C all show different views of the same rail. Therefore, the examiner withdraws the assertion that figures 2A, 2B and 2C are obvious variants of one another. As such, claims 29 and 30 are no longer withdrawn from consideration.

Claims 2,10, 11, 12 (directed towards non-elected fig.1E), 13, 16, 17, 19, 20 and 38-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 8, 14, 21-23, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 2218953 to Gustafson.

Claim 1. Gustafson discloses (fig3) a picket fence and rail mounting system comprising: at least an upper and lower, elongate rail (16) in spaced relation to one another, each rail having a hollow interior defining a substantially I-shaped cross-section having a first surface (top of 16), a second surface (bottom of 16), at least a first slot (receiving top of 25) adjacent the first surface,

at least a second slot (receiving bottom of 25) adjacent the second surface, a plurality of spaced openings in the first surface (21), and a channel (between 18) in the second surface, the channel having a width that is at least as wide as the width of each opening; at least one elongate picket (10) having a first end (top of 10) and a second end (bottom of 10), at least a first notch (top 24) or indentation in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails; and an elongate retaining rod (27) disposed within at least one rail, wherein each rod cooperates with a notch (24) on each picket to secure the picket to the rail; and wherein each rod is alternately disposable within a first slot (receiving top of 25) of the upper rail, and alternately ~~disposable~~ (but not necessarily disposed) within a first or second slot of the lower rail, each rail **may be** (but is not necessarily) alternately oriented such that the first surface resides above the second surface and vice versa. Note that the claim language of the applicant does not state that hollow interior of the rail is I-shaped only that it is **substantially** I-shaped. Gustafson meets this limitation since the hollow interior of 16 is shaped as the middle portion of an I, which is a substantial portion of an I.

Claim 3. Gustafson discloses (fig.3) that the first notch or indentation is located near the first end and the picket further comprises a second notch (bottom 24) or indentation near the second end.

Claim 4. Gustafson discloses (fig.3) that the notches or indentations on each picket are in one picket face (left face of 10).

Claim 8. As noted in the rejection of claim 7 Gustafson discloses all of the limitations of claim 8 that are present in claim 7. Gustafson further discloses (fig.3) that a rod (bottom 25)

cooperates with the second notch (bottom 24) on each picket, the second end of each picket extends upwardly a distance  $y$  from the first surface of the upper rail and the first end of each picket extends downwardly a distance  $x$  from the second surface of the lower rail, wherein  $y$  is greater than  $x$  (fig.1).

Claim 14. Gustafson discloses (fig.3) that an exterior surface of each rail defines a substantially I-shaped cross-section. Note that the claim language of the applicant does not state an I-shaped exterior only that the exterior surface is **substantially I-shaped**. Gustafson meets this limitation since the exterior surface of 16 is shaped as the middle portion of an I, which is a substantial portion of an I.

Claim 21. As noted in the rejection of claim 1, Gustafson discloses all of the limitations of claim 21 that are present in claim 1, wherein the first notch is a first hole. Gustafson further discloses (fig.3) fastening members (25) cooperating with at least one of the holes to secure the picket to the rail, wherein each rail may be alternately oriented such that the first surface faces downward.

Claim 22. Gustafson discloses (fig.3) that the fastening members comprise spring clips (25).

Claim 23. Gustafson discloses (fig.3) that the spring clips **may be** (but are not necessarily) inserted within the first or second slot of the upper rail, and the spring clips **may be** (but are not necessarily) inserted within the first slot or the second slot of the lower rail.

Claim 29. Gustafson discloses (fig.3) a picket fence rail comprising: an elongate rail (16) having a hollow interior defining a substantially I-shaped cross-section having a top wall (top of 16), a bottom wall (bottom of 16) spaced from the top wall, a top slot (receiving top portion of

25) adjacent the top wall, a bottom slot (receiving bottom portion of 25) adjacent the bottom wall, a plurality of spaced openings (receiving pickets 10) in the top wall, and an elongate channel (between 18) in the bottom wall, the channel having a width that is at least as wide as the width of each opening so that an elongate picket (10) may extend through each opening and the channel, the top slot being sized to receive a retaining member (25) to cooperate with a notch (24) in the picket to secure the picket to the rail.

Claim 30. Gustafson discloses that the top slot is sized to receive an elongate retaining rod.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 9, 15, 18, 25-28 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 2218953 to Gustafson.

Claims 5 and 6. Gustafson does not disclose that the notches or indentations on each picket are in oppositely facing picket faces or that a distance between the first picket end and first notch or indentation is shorter than a distance between the second picket end and second notch or indentation. It has generally been recognized that the rearranging of parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the notches and notch

distances disclosed by Gustafson such that the notches are located on oppositely facing picket faces and a distance between the first picket end and first notch or indentation is shorter than a distance between the second picket end and second notch or indentation, as such practice is a design consideration within the skill of the art.

Claims 7 and 9. Gustafson discloses (fig.3) that with both the upper and lower rails oriented such that the first surface of each faces upward, and each picket oriented such that the first end of each faces upward and the second end of each faces downward, the retaining rod (25) residing within the first rail slot (portion of 16 receiving top of 25) in the upper rail such that the rod cooperates with the first notch or indentation on each picket, the first end of each picket extends upwardly a distance x from the first surface of the upper rail and the second end of each picket extends downwardly a distance y from the second surface of the lower rail. Gustafson does not disclose that y is greater than x or that every other picket is upside down. It has generally been recognized that the rearranging of parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the location of the picket disclosed by Gustafson such that y is greater than x and that every other picket is upside-down; as such practice is a design consideration within the skill of the art.

Claims 15 and 18. Gustafson does not disclose that the pickets are tubular or that the rod has a flattened-oval cross-section. It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the shape of picket to be tubular and the rod

to have a flattened-oval cross-section, as such practice is a design consideration within the skill of the art.

Claim 25. Gustafson discloses (fig.3) a picket fence and rail mounting system comprising: an elongate, substantially hollow rail (16) having a top wall (top of 16) with a plurality of spaced openings (21), and a bottom wall (bottom of 16) with an elongate channel (between 18) having a width that is at least as wide as the width of each opening, the rail having a first interior width (from left 17 to right 17) at a vertical center thereof, the first interior width being measured in a horizontal direction from a first inside surface thereof to a second inside surface thereof, and a second interior width (from top left corner to top right corner) at a height just beneath the top wall, the second interior width being measured in a horizontal direction from the first inside surface to the second inside surface, thus defining an interior elongate slot (receiving top of 25) adjacent the top wall; at least one elongate picket (10) with a notch (24) in a side of the picket, and a cross-sectional shape sized to fit snugly (where 10 contacts 16) within one of the openings and the channel; and an elongate retaining rod (25) disposed within the slot and the notch to secure the picket to the rail. Gustafson does not disclose that the second interior width is greater than the first interior width. It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the shape of the rail (16) such that the second interior width is greater than the first interior width, as such practice is a design consideration within the skill of the art.

Claim 26. Gustafson discloses (fig.3) that the rail may be alternately oriented such that the top wall faces upward or the channel faces upward. The claim language of the applicant does not state that the rail is alternately oriented... only that “the rail **may** be alternately oriented...” Gustafson meets this limitation since the rail (16) is fully capable of and **may** be alternately oriented...

Claim 27. Gustafson discloses (fig.3) that the picket notch is a first picket notch (top 24) located near a first picket end (top of 10), and the picket further comprises a second notch (bottom 24) or indentation near a second picket end (bottom of 10).

Claim 28. As noted in the rejection of claim 6, Gustafson discloses all of the limitations of claim 28.

Claim 43. Gustafson discloses (fig3) a picket fence and rail mounting system comprising: at least an upper and lower, elongate rail (16) in spaced relation to one another, each rail having a hollow interior defining a substantially I-shaped cross-section having a first surface (top of 16), a second surface (bottom of 16), at least a first slot (receiving top of 25) adjacent the first surface, at least a second slot (receiving bottom of 25) adjacent the second surface, a plurality of spaced openings in the first surface (21), and a channel (between 18) in the second surface, the channel having a width that is at least as wide as the width of each opening; at least one elongate picket (10) having a first end (top of 10) and a second end (bottom of 10), at least a first notch (top 24) or indentation in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails; and an elongate retaining rod (27) disposed within at least one rail, wherein each rod cooperates with a notch (24) on each picket to secure the picket to the rail; and wherein each rod is alternately

disposable within a first slot (receiving top of 25) of the upper rail, and alternately **disposable** (but not necessarily disposed) within a first or second slot of the lower rail, each rail **may be** (but is not necessarily) alternately oriented such that the first surface resides above the second surface and vice versa. Gustafson discloses a **substantially** I-shaped rail but not an I-shaped rail. It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the shape of Gustafson's substantially I-shaped rail to be I-shaped as such practice is a design consideration within the skill of the art.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 2218953 to Gustafson in view of USPN 5557893 to Bowls.

Gustafson does not explicitly disclose that the fasteners comprise threaded screws. Bowls teaches (col.6, ll.7-14) that screws are beneficial for supporting pickets. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the fence of Gustafson to include screw fasteners for the benefit of further supporting the pickets, in view of the motivating teaching of Bowls.

#### *Response to Arguments*

The applicant argues that the hollow interior of Gustafson is not substantially I-shaped. This is not persuasive since the word "substantially" is taken by the examiner to mean "being largely but **not wholly** that which is specified" in accordance with Merriam-Webster's Collegiate

Dictionary Tenth Edition. Gustafson meets this limitation since the hollow interior of 16 is shaped as the middle portion of an I, which is a large portion of an I.

The applicant argues that Gustafson does not disclose a second interior width greater than a first interior width. This is not persuasive since it is noted that the features upon which applicant relies (i.e., first interior width, second interior width, etc.) are not recited in the originally rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner notes that claim 25 has since been amended to include the above-mentioned limitations but directs the applicant's attention to the new rejection to claim 25 above, necessitated by amendment.

The applicant argues that changing the position of the notches in the pickets would change the operation of the fence over that of Gustafson and that the citing of *In re Japikse*, 37 C.C.P.A. 1026 in support of an obviousness rejection of claims 5 and 6 is improper. This is not persuasive since the applicant has not stated how changing the location of the notches changes how the picket fence and rail mounting system operate but rather admits (p.14, ll.4-6) that the positioning of the notches is merely an aesthetic design consideration. Furthermore, it appears that the fence of Gustafson would operate the same regardless of whether or not the location of the notches is modified as detailed in the rejection of claims 5 and 6.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



John R. Cottingham  
Patent Examiner



Lynne H. Browne  
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VLM  
July 26, 2003